

## **II. Remarks**

By this amendment, applicants have amended claims 9 and 11, without prejudice. By previous amendments, applicants canceled claim 1, without prejudice. Claims 1-11 are pending in the application. The amendment to claim 9 finds support in paragraphs [0013] - [0015] and in Figs. 3-4. The amendment to claim 11 finds support in paragraph [0011] and Fig. 1. Therefore, no new matter is introduced. Favorable reconsideration of this application is respectfully requested in light of the above amendments and the following detailed discussion.

### Claim Rejections – 35 U.S.C. § 102

The Examiner has rejected claims 2, 3, and 11 under 35 U.S.C. 102(e) as being anticipated by Platz (U.S. Patent No. 6,416,341, hereinafter Platz). The Examiner asserts that Platz discloses various elements of claim 11.

Applicants, however, have amended claim 11 to further require at least the limitations that said internal electrical connector comprises at least two male portions extending essentially perpendicular from said interior of said housing and said electrical leads extending between said male portions, wherein said internal connector facilitating an electrical connection to said electrical device.

One skilled in the art would recognize that the internal electrical connector of the present application would easily be connected to and disconnected from the electrical device via the internal connector having the at least two male portions. On the other hand, Platz does not teach these added limitations. Instead, as Platz' Fig. 1 illustrates,

there are no male portions extending essentially perpendicular from the interior of the housing so as to facilitate connecting the contact pins 6 to the conductor tracks 5. In fact, Platz discloses that the contact pins are **shot** into the conductor tracks (see, for example, column 3, lines 10-11).

Since independent claim 11 is patentable, then claims 2 and 3, which directly depend from claim 11, are also patentable over Platz, at least on this basis.

Therefore, applicants respectfully submit that claims 2-3 and 11 are not anticipated by Platz, as the invention defined thereby is not identically disclosed in Platz, as required by 35 U.S.C. § 102(e).

Accordingly, withdrawal of the rejection of claims 2-3 and 11 and favorable reconsideration of claims 2-3 and 11 are respectfully requested. Claims 2-3 and 11 should be allowed over Platz.

#### Claim Rejections – 35 U.S.C. § 103

A. The Examiner has rejected claims 4 and 5 as unpatentable over Platz in view of Mathews et al. (U.S. Patent No. 5,035,637, hereinafter Mathews).

Since independent claim 11 is patentable, then claims 4 and 5, which directly or indirectly depend from claim 11, are also patentable over Platz in view of Mathews, at least on this basis.

Applicants traverse the 35 USC 103 rejections of claims 4 and 5 by asserting that each reference (Platz and Mathews) needs to be taken as a whole, when combined with the other reference. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540,

1550, 220 USPQ 303, 311 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (it is error to consider "references in less than their entireties ...".)

Regarding claim 4, the Examiner concedes that Platz fails to disclose that the housing 1 comprises a valve cover for an internal combustion engine vehicle, as the claimed invention requires. Then, the Examiner asserts that Mathews teaches the use of a valve cover for an internal combustion engine vehicle.

Mathews, however, does nothing to overcome the above-stated shortcomings of Platz' housing. In fact, Mathews teaches **away** from the claimed invention of claims 4 and 5 by disclosing an engine valve cover *gasket* incorporating an electrical conductor for creating an electrical bridge **through** the sealing area between the cylinder head and valve cover (see, for example, Mathews' Abstract).

In addition, *if* the valve cover 27 of Mathews (as the Examiner proposes) were to replace the prior art housing of Platz' Fig. 1, then the contact pins 3, 6 and the conductor tracks 5 of Platz would no longer exist because the *engine valve cover gasket with electrical bridge* (see, for example, Mathews' Title) would replace Platz' electrical contact system. As a result, the limitations that the electrical bridge system integrally comprises both an external electrical connector on an exterior of said housing and an internal electrical connector on an interior of said housing, each connector integrally formed with one or more electrical leads integrally formed in and through the housing could not be satisfied.

Therefore, claims 4-5 are patentable over Platz in view of Mathews, as the claimed invention defined thereby is not suggested within either Platz or Mathews, nor

is there any suggestion or motivation to modify these references' teachings in order to teach or suggest the claimed limitations, as required by 35 U.S.C. § 103.

Applicants respectfully request withdrawal of the rejections of claims 4-5 and favorable reconsideration of claims 4-5. Accordingly, claims 4-5 should be allowed over Platz in view of Mathews

B. The Examiner has rejected claims 6-8 and 10 under 35 U.S.C. 103(a) as being unpatentable over Platz as modified above (taken to mean in view of Mathews) and further in view of Billimack et al. (U.S. Patent No. 6,371,073, hereinafter Billimack).

Since independent claim 11, from which claims 6-8 and 10 directly or indirectly depend, is patentable over Platz and further over Platz in view of Mathews, then claims 6-8 and 10 are also patentable over Platz in view of Mathews and further in view of Billimack, at least on this basis.

The Examiner asserts that in regard to claim 6, Mathews as modified above discloses the claimed invention as recited above. However, the Examiner concedes that Platz fails to disclose that the cover comprises an oil pan upon the cylinder head. On the other hand, the Examiner asserts that Billimack teaches that the cover comprises an oil pan, wherein Billimack teaches the cover or oil pan cover being upon the cylinder head (see column 4, lines 30 to 35).

From this the Examiner asserts that it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to modify the device of Mathews as modified above, by providing an oil pan as taught by Billimack, thus the moving parts in the cylinder head would then be lubricated.

If, however, the *isolated cover with independent sealing system 10* (see, for example, Billimack's Title) of Billimack (as the Examiner proposes) were to replace the prior art sealing system of Mathews, then the engine valve cover gasket 10 with electrical bridge 19 of Mathews would no longer exist and the purpose of Mathews would be destroyed. In addition, as mentioned above, Mathews destroys the purpose of Platz. Again, the limitations that the electrical bridge system integrally comprises both an external electrical connector on an exterior of said housing and an internal electrical connector on an interior of said housing, each connector integrally formed with one or more electrical leads integrally formed in and through the housing could not be satisfied.

The Examiner asserts that in regard to claim 10, Billimack discloses that the base component comprises a transmission by way of disclosing a base component that is a flywheel housing (18) or an engine cylinder block (16) (see the single figure of Billimack).

The Examiner asserts that in regard to claim 7, Mathews as modified in the rejection above discloses that the housing comprises a bottom "pan" flange (per the labeled prior art Fig. 1 in the Office Action of 03/05/2007).

The Examiner asserts that in regard to claim 8, Mathews discloses a "premold" positioned along a periphery of the bottom pan flange (see numeral 12). As to the method of "premold", the Examiner asserts that a product by process claim is rejected over a prior art product that appears to be identical, although produced by a different process. Further, the Examiner asserts that the burden is upon the applicants to come

forward with evidence establishing an unobvious difference between the two and the Examiner cites *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983).

Specifically regarding claim 8, the gasket body 12 of Mathews, as the Examiner alleges, is not equivalent to the premold of the claimed invention. In the subject application, the premold supports one or more electrical leads (see, for example, paragraph 14 and Fig. 3) that are positioned on the inside the bottom of the pan flange. On the other hand, the gasket body 12 of Mathews provides access from *outside* of the enclosure area to the *inside* of the enclosure area, between the valve cover 27 and the cylinder head 28.

Also, applicants assert that the term "premold" is not intended to limit the claim as a method associated with a product by process. Instead, the premold, as seen in Figs. 3 and 4, is a term to be taken to identify a physical support for electrical leads that extend between the external electrical connector and the internal electrical connector (see, for example, paragraph [0014] and Figs. 3-4).

Therefore, claims 6-8 and 10 are patentable over Platz in view of Mathews, and further in view of Billimack, as the claimed invention defined thereby is not suggested within Platz, Mathews, and/or Billimack, nor is there any suggestion or motivation to modify these references' teachings in order to teach or suggest the claimed limitations, as required by 35 U.S.C. § 103.

Thus, claims 6-8 and 10 should be allowed over Platz in view of Mathews, and further in view of Billimack. Accordingly, the withdrawal of the rejections of claims 6-8

and 10, and the favorable reconsideration of claims 6-8 and 10 are respectfully requested.

C. The Examiner has rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over Platz as modified above (taken to mean in view of Mathews) and further in view of Lee (U.S. Patent No. 5,863,424, hereinafter Lee).

The Examiner asserts that Platz, as modified above, discloses the claimed invention of claim 9. However, the Examiner concedes that Platz fails to disclose a gasket disposed between the bottom pan flange and a fluid filter. But then, the Examiner contends that Lee teaches a gasket disposed between the bottom flange and a fluid filter (see figure 12).

Applicants, however, have amended claim 9 to further require at least the added limitations that a housing shaped to integrally comprise both an external electrical connector on an exterior of the housing and an internal electrical connector on an interior of the housing, the external connector integrally formed with one or more electrical leads integrally formed in and through the housing, the internal connector integrally formed with one or more electrical leads therein; the external electrical leads in electrical communication with the internal electrical leads; and the internal electrical connector comprising at least two male portions extending essentially perpendicular from the interior of the housing and the internal connector electrical leads extending between the male portions; wherein, the connectors and the leads form an electrical bridge from an electrical source located outside the enclosure to an electrical device

located inside the enclosure, and the internal connector facilitating an electrical connection to said electrical device.

One skilled in the art would recognize that the internal electrical connector of the present application would easily be connected to and disconnected from the electrical device via the internal connector having the at least two male portions. On the other hand, Platz does not teach these added limitations. Instead, as Platz' Fig. 1 illustrates, there are no male portions extending essentially perpendicular from the interior of the housing so as to facilitate connecting the contact pins 6 to the conductor tracks 5. In fact, Platz discloses that the contact pins are **shot** into the conductor tracks.

Regarding Mathews and Lee, these references do nothing to overcome the above-stated shortcomings of Platz. In fact, Mathews teaches **away** from the claimed invention of claim 9 by disclosing an engine valve cover *gasket* incorporating an electrical conductor for creating an electrical bridge **through** the sealing area between the cylinder head and valve cover.

In addition, *if* the valve cover 27 of Mathews were to replace the prior art housing of Platz' Fig. 1, then the contact pins 3, 6 and the conductor tracks 5 of Platz would no longer exist in this Platz/Mathews combination. As a result, the above-stated claim limitations could not be satisfied. Lee does nothing to overcome these shortcomings of Mathews.

Thus, applicants assert that claim 9 is patentable over Platz in view of Mathews and further in view of Lee, as the invention defined thereby is not suggested by either Platz, Mathews and/or Lee, nor is there any suggestion or



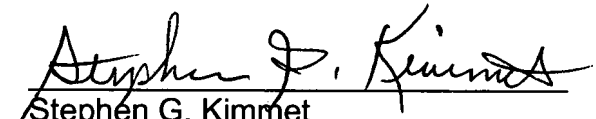
motivation to modify teachings of these references in order to teach or suggest the claimed limitations, as required by 35 U.S.C. § 103.

Applicants respectfully submits that claim 9 of the present application is allowable over Platz in view of Mathews and further in view of Lee. Accordingly, withdrawal of the rejection of claim 9 and favorable reconsideration of claim 9 are respectfully requested.

For all the reasons described in the preceding paragraphs, applicants respectfully submit that the present application is now in condition for allowance. Accordingly, a timely action to that end is courteously solicited.

If the Examiner has any remaining questions or concerns, or would prefer claim language different from that included herein, the favor of a telephone call to applicants' attorneys is requested.

Respectfully submitted,

  
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